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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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09/589,217

06/07/2000

David Cooper

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23389 7590 12/27/2007

SCULLY SCOTT MURPHY & PRESSER, PC

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SUITE 300

GARDEN CITY, NY 11530

EXAMINER

PHAN, HUY Q

ART UNIT

PAPER NUMBER

2617

MAIL DATE

DELIVERY MODE

12/27/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                        |  |                     |  |
|------------------------------|------------------------|--|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> |  | <b>Applicant(s)</b> |  |
|                              | 09/589,217             |  | COOPER, DAVID       |  |
|                              | <b>Examiner</b>        |  | <b>Art Unit</b>     |  |
|                              | Huy Q. Phan            |  | 2617                |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 November 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 28, 29 and 32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 28, 29 and 32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                      |                                                                   |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____                                                          | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/02/2007 has been entered.

### ***Response to Amendment***

2. This Office Action is in response to Amendment filed on date: 11/02/2007.

Claims 28, 29 and 32 are still pending.

Claims 1-27, 30 and 31 are cancelled.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 28 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lynch (US 5,761,618) in view of Daly (US-6,122,503; previously cited).

Regarding claim 28, Lynch discloses a method for user equipment (fig. 1, 12) for a mobile communication system (fig. 1, 10) comprising:

receiving a message that includes a first list including a plurality of network identifiers ("stored preferred SID list"; col. 12, lines 1-8) that are available for a potential handover ("hand-off", col. 12, lines 1-8), from the communication network (fig. 1, 10 and fig. 5); and

comparing ("compared", col. 12, lines 1-8) the received first list ("stored preferred SID list"; col. 12, lines 1-8) with a second list which includes at least one network identifier ("received SIDs"; col. 12, lines 1-8) and is stored in the user equipment ("stored"; col. 12, lines 1-8).

But, Lynch does not particularly show the at least one network identifier in the second list being an identifier of a network that is never to be used. However in analogous art, Daly teaches the at least one network identifier in the list being an identifier of a network that is never to be used ("forbidden" see col. 8, lines 15-27); therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Lynch as taught by Daly in order to "control the intelligent roaming function" of the user equipment since the intelligent roaming is "a process that a mobile station or phone goes through to assure that it is receiving the best service possible regardless of the location that the phone is in" (see col. 1, lines 20-25 and col. 8, lines 13-15).

Regarding claim 29, Lynch discloses user equipment (fig. 1, 12) for a mobile communication network (fig. 1, 10) comprising:

means for receiving a message that includes a first list ("stored preferred SID list"; col. 12, lines 1-8) including a plurality of network identifiers that are available for a potential handover ("hand-off", col. 12, lines 1-8), from the communication network (fig. 1, 10 and fig. 5); and

means for comparing ("compared", col. 12, lines 1-8) the received first list ("stored preferred SID list"; col. 12, lines 1-8) with a second list which includes at least one network identifier ("received SIDs"; col. 12, lines 1-8) and is stored in the user equipment ("stored"; col. 12, lines 1-8).

But, Lynch does not particularly show the at least one network identifier in the second list being an identifier of a network that is never to be used. However in analogous art, Daly teaches the at least one network identifier in the list being an identifier of a network that is never to be used ("forbidden" see col. 8, lines 15-27); therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the user equipment of Lynch as taught by Daly in order to "control the intelligent roaming function" of the user equipment since the intelligent roaming is "a process that a mobile station or phone goes through to assure that it is receiving the best service possible regardless of the location that the phone is in" (see col. 1, lines 20-25 and col. 8, lines 13-15).

II) Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lynch (US 5,586,338) in view of Daly (US-6,122,503; previously cited) and further in view of Grandhi (US 6,125,280).

Regarding claim 32, Lynch discloses a mobile communications network (fig. 1, 10) or component (fig. 1, 12) thereof including:

means for receiving by a user equipment (fig. 1, 12) a message (col. 8, lines 1-4) that includes a first list ("stored preferred SID list"; col. 12, lines 1-8) including a plurality of network identifiers that are available for a potential handover ("hand-off", col. 12, lines 1-8), from the communication network (fig. 1, 10 and fig. 5);

means for comparing ("compared", col. 12, lines 1-8) by the user equipment the received first list ("stored preferred SID list"; col. 12, lines 1-8) with a second list which includes at least one network identifier from the plurality of network identifiers ("received SIDs"; col. 12, lines 1-8) and is internally stored in the user equipment ("stored"; col. 12, lines 1-8); and

means for receiving from user equipment communicating with the network an indication of a preferred other network (col. 10, lines 55-60 and/or col. 11, lines 38-59).

But, Lynch does not particularly show the at least one network identifier in the second list being an identifier of a network that is never to be used. However in analogous art, Daly teaches the at least one network identifier in the list being an identifier of a network that is never to be used ("forbidden" see col. 8, lines 15-27); therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the user equipment of Lynch as taught by Daly in order to

"control the intelligent roaming function" of the user equipment since the intelligent roaming is "a process that a mobile station or phone goes through to assure that it is receiving the best service possible regardless of the location that the phone is in" (see col. 1, lines 20-25 and col. 8, lines 13-15).

But, Lynch and Daly do not particularly show means for supplying neighboring cell information for the preferred other network based on the indication. However in analogous art, Grandhi teaches means for supplying neighboring cell information for the preferred other network based on the indication ("provides automatic identification of neighbor cells, and configuration of neighbor cell information"; see col. 3, lines 19-23); therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the network of Lynch and Daly as taught by Grandhi in order to improve the handoff process in the wireless communication system, since Grandhi specifically discloses that "Handoff processes use neighbor information to help decide the most appropriate sector or cell to serve a call" (col. 1, lines 53-58).

### ***Conclusion***

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a) Baber discloses that "When the Roam Saver carrier selection mode is selected by the user, while the cellular telephone 10 will prefer service through a carrier broadcasting a SID matching a SID on the preferred list, the cellular telephone 10 will never deny service to emergency or non-emergency destinations if any SID, including

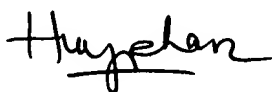
one not on the preferred list, is detected by the cellular telephone 10" (see specification).

b) Leopold discloses that "such procedures may continuously monitor their availability lists to note when channels become unavailable and to handoff calls to other channels that may then be available" (see specification).

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Huy Q Phan whose telephone number is 571-272-7924. The examiner can normally be reached on 8AM-6PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Eng can be reached on 571-272-7495. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Examiner: Phan, Huy Q.

AU: 2617

Date: 12/20/2007